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**REMARKS/ARGUMENTS**

This paper is responsive to the outstanding Office Action mailed December 13, 2005. After entering this response, claims 1-12, 15-20, 22, 24-29, and 31-33 are pending. Claim 16 has been cancelled as a substantial duplicate of claim 11.

In view of the Amendments and the arguments made below, it is believed that the claims are now in condition for allowance. The Applicant therefore respectfully requests reconsideration and withdrawal of the rejection.

**Double Patenting**

The Office Action provisionally rejected claims 22-33 under 35 U.S.C. § 101 as claiming the same invention as claims 22-33 of co-pending U.S. Application No. 10/770,348. Applicants have filed a preliminary amendment concurrently with this response deleting the duplicative claims in the '348 Application. An unexecuted copy of this preliminary amendment is enclosed with this response. The rejection of claims 22-33 is therefore obviated.

In addition, claims 1-21 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-51 of U.S. Application No. 10/770,348. Applicants also request that this rejection be held in abeyance pending a patentability determination regarding the pending claims. If claims are allowed for which a terminal disclaimer is required, a terminal disclaimer will be timely filed.

**Claim Rejections-35 U.S.C. § 102****Independent Claim 33 Is Not Anticipated by *Schroeter***

Independent claim 33 has been rejected under 35 U.S.C. § 102(b) as anticipated by *Schroeter* (U.S. Pat. No. 5,307,801). The Applicant respectfully submits that *Schroeter* neither discloses nor suggests all of the features recited in claim 33 as amended. Applicant therefore respectfully requests reconsideration and withdrawal of this rejection.

*Schroeter* discloses a fireplace that includes a "firebox which has a flue and a front." Abstract. The fireplace includes a "right front casing panel 20, left front casing panel 22, and upper front casing panel 24" that "are positioned at the side and top periphery of the front of the fireplace." Col. 3, lines 43-46. In addition, "a passage is provided for the circulation of air along

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the outside of the panels of the firebox.” Col. 4, lines 53-55. “[R]oom air enters lower room air plenum 56 via room air entry port 62, travels along the bottom of the firebox and then up the rear of the firebox through rear room air plenum 58 and then across the top of the firebox through upper room air plenum 62 to exit the fireplace via room air exit port 74.” Col. 5, lines 35-40.

The room air exit port 74 is defined by the inside edges of the left and right front casing panels 20, 22, but is set entirely below the upper front casing panel 24. Moreover, the room air exit port 74 vents air directly from the fireplace and into the room, not through any part of the casing panels 20, 22, or 24. The exit port therefore does not define an “aperture that extends through a top member of the surround, the surround aperture allowing air to vent from the plenum opening through the top member of the surround” as claimed in claim 33 (emphasis added). In addition, *Schroeter* does not teach or disclose a “surround including a cavity therein.” *Schroeter*, therefore, does not teach suggest or disclose all of the limitations of claim 33.

Claim 33 is not anticipated by and does not read upon *Schroeter*. Reconsideration and withdrawal of the rejection of independent claim 33 based upon *Schroeter* is respectfully requested.

Independent Claims 1, 12, 17, 22, and 33 Are Not Anticipated by *Bachinski*

Independent claims 1, 12, 17, 22, and 33 were rejected under 35 U.S.C. § 102(e) as anticipated by *Bachinski* (U.S. Pat. Publication No. 2004/0011352). The Applicant respectfully submits that *Bachinski* neither discloses nor suggests a fireplace surround that includes all of the features recited in claims 1, 12, 17, 22, and 33 as *Bachinski* does not disclose a fireplace surround that includes an opening defined by the top member and including a cavity therein. *Bachinski* also does not disclose a shield or insulating member configured to fit into the cavity. Applicant therefore respectfully requests reconsideration and withdrawal of this rejection.

*Bachinski* discloses a fireplace with an “exposed panel defining an exposed surface” wherein the exposed panel further includes a touch portion that is “isolated from heat generated within the combustion chamber.” Abstract. The front panel 103 includes grills 150 and 160 and the fireplace may include a surround positioned in front of front panel 403. The surround can be used to “thermally isolate the activation portion 415 from the heat generated by the fireplace

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400" by placing the surround in a spaced apart relationship from front panel 403 or by forming the surround with and insulative material. See par. 38.

In contrast, the present invention claims a fireplace or fireplace surround that includes "top member defining a cavity therein" (claims 1, 12), "a cavity formed within the first member" (claim 17), "forming a cavity within the first member" (claim 22), or "the surround including a cavity therein" (claim 33). *Bachinski* does not include the formation of a cavity in the top member or in the surround. Rather, the surround in *Bachinski* is simply placed in a spaced apart relationship to the fireplace or is formed of a flat piece with a hole in it, which can not include a cavity therein as defined and claimed.

In addition, several of the independent claims include a shield member and/or an insulation member configured to fit within the cavity. For example:

- "a shield member configured to fit within a portion of the cavity, the shield member further configured to direct heated air exhausted from the vent through the cavity;" (claim 1)
- "a shield member configured to fit within a portion of the cavity, the shield member further configured to direct heated air exhausted from the vent through the cavity; an insulating member configured to fit within a portion of the cavity;" (Claim 12)
- "a shield member configured to fit within a portion of the cavity, the shield member further configured to direct heated air through the cavity; and an insulating member positioned in the first member;" (Claim 17)
- "forming a cavity within the first member, wherein the opening provides access to the cavity; and positioning an insulating member in the cavity;" (Claim 22)

The claims of the present application therefore require that the top member including a cavity that is positioned within the top member, the first member, or the surround and also a shield member and/or an insulation member configured to within the cavity. *Bachinski* therefore does not teach an article that includes a cavity as defined and claimed or a shield or insulation that can fit in that cavity.

*Bachinski*, therefore, does not teach suggest or disclose the invention as claimed in claims 1, 12, 17, 22, and 33. In addition, claims 1, 12, 17, 22, and 33 do not read upon the fireplace and fireplace surrounds disclosed in *Bachinski*.

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For at least these reasons, reconsideration and withdrawal of the rejection based upon *Bachinski* is respectfully requested. In addition, dependent claims 2-11, 15-16, 19-20, 24-29, and 30-31 depend directly or indirectly from independent claims 1, 12, 17, and 22 and are therefore also allowable for at least these same reasons.

Claims 11, 6, 31, and 32 were also rejected as obvious over *Duffney* in view of *Schroeter* and in further view of *Moore* (U.S. Patent No. 3,758,317). However, because each of these claims depend from an allowable claim they are all in condition for allowance for at least the same reasons as stated above.

#### **The Present Claims Are Not Obvious Over the Cited Art**

Independent claims 1, 12, 17, and 22 were rejected under 35 U.S.C. § 103(a) in view of *Duffney* (U.S. Pat. No. 6,409,870) in view of *Schroeter*. The combination of *Duffney* and *Schroeter*, however, does not teach, disclose, or suggest all of the limitations of independent claims 1, 12, 17, and 22. Further, independent claims 1, 12, 17, and 22 do not read upon the combination of *Duffney* and *Schroeter*.

*Duffney* discloses a decorative molding that may be used as a fireplace surround. The decorative molding includes a frame 11 that may include a "plurality of artistic cutouts 20" that are formed "through the front face section 18" of the frame 11. Col. 4, lines 42-44. "A longitudinal groove 2 is preferably centrally milled within the rear surface 22" of the frame 11. *Id.* at lines 59-61. "A filler material 30 having a colored surface 32 is preferably positioned within the longitudinal groove 24 and is further preferably secured to the first interior surface" of the frame 11. Col. 5, lines 7-9.

In contrast, as recited above, the present invention includes a fireplace or a fireplace surround that includes a "top member defining a cavity therein" (claims 1, 12), "a cavity formed within the first member" (claim 17), "forming a cavity within the first member" (claim 22), and "the surround including a cavity therein" (claim 33). Moreover, as further noted above, each claim recites a shield portion or an insulative material that is configured to fit within a portion of the cavity. *Duffney* only teaches and discloses forming decorative cutouts and placing a colorful backing on the inside of the surround such that it appears through the cutout. The backing is never configured or placed within the cutout. Moreover, *Duffney* teaches away from claimed

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invention as each of the cutouts 20 of *Duffney* are covered with a backing such that there is no aperture or other path through the decorative molding.

*Schroeter* does not remedy his failure as it does not disclose a cavity and a shield or an insulative material configured to fit within a portion of the cavity. Moreover, if *Schroeter* were to be combined with *Duffney*, then the filler material 30 would be placed over any of the cutouts 20 or exhaust feature of opening 74 in *Schroeter*.

Reconsideration and withdrawal of the rejection of claims 1, 12, 17, and 22 is therefore respectfully requested. In addition, dependent claims 2-5, 8-10, 15, 20, 24-26 and 29 depend directly or indirectly from independent claims 1, 12, 17, and 22 and are therefore also allowable for at least these same reasons.

#### CONCLUSION

All of the claims remaining in this application should now be seen to be in condition for allowance. The prompt issuance of a notice to that effect is respectfully solicited. If there are any remaining questions, the Examiner is requested to contact the undersigned at the number listed below.

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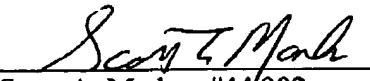
**PETITION FOR EXTENSION OF TIME**

The Applicant herewith petitions the Commissioner to extend the time for reply to the Office Action dated December 13, 2005 for one (1) month, from March 13, 2006, to April 13, 2006. A credit card payment form in the amount of \$120.00 for a one-month extension of time is submitted herewith. No additional fee is believed to be necessary for the entry of this paper. Should any additional fee be required for entry of this paper, the Commissioner is authorized to charge the Faegre & Benson Deposit Account No. 06-0029 and in such event, is requested to notify us of the same.

Respectfully Submitted,

FAEGRE &amp; BENSON LLP

By:

  
Scott A. Marks, #44,902  
Customer No.: 58506

Dated: April 13, 2006  
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